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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,220	09/05/2003	Su-Hsian Yiu Lu	2450-0539P	6997

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EXAMINER	
VANAMAN, FRANK BENNETT	
ART UNIT	**PAPER NUMBER**
3618	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/655,220	YIU LU, SU-HSIAN	
	Examiner	Art Unit	
	Frank Vanaman	3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 September 2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first adjusting member being located on the toe cap must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The abstract of the disclosure is objected to because of the following informality: on line 7, it appears as though "matching worms" should be –matching threads–. Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because it is replete with minor grammatical informalities, such as: on page 1, line 11, "between 200,000 and 300,000 of people"; page 1, line 12, "participate this exercise"; page 2, lines 3-4 "As there are many jumping actions occurred"; on page 2, line 14, "adopt an integrated forming"; page 4, lines 24-25, "adopted a conventional technique" (also note page 5, lines 1-2); page 5, line 19, "for adjusting the tight and loose fitness". The entire specification should be carefully

reviewed for grammatical informalities and revised. It is not clear why such a review and revision has not taken place before the filing of this application in the Office.

Appropriate correction is required.

Claim Objections

4. Claim 1 is objected to because of the following informalities: in claim 1, line 2, "worn by a foot of users" is informal. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. Claims 2-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 2 recites that the first adjusting member is on the toe cap. The specification and drawings as filed fail to support such a limitation. See page 6 of the specification, at lines 15-18, which appears to completely contradict this recitation.

6. Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 2, the recitation of the first adjusting member being located on the toe cap is confusing in that claim 1, lines 10-11 recites that the first adjusting member is located on the heel cap.

7. As regards claims currently rejected under 35 USC §112, second paragraph, please note that rejections under 35 USC §102 and 103 should not be based upon considerable speculation as to the meaning of the terms employed and assumptions as to the scope of the claims when the claims are not definite. See In re Steele 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become anticipated or obvious, but rather the claim becomes indefinite. See In re Wilson 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). As such the currently pending claims may be

subject to prior art rejections not set forth herein upon the clarification of the claim language.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu (US 5,645,288) in view of Flamm (US 2,245,769). Lu teaches an in line roller skate having adjustable dimensions, including a truck (13) having a sliding track (12) on a top section thereof, and a plurality of wheels (5) on a bottom section thereof; a two piece shoe cap including a toe cap (2) anchored on the truck, and a heel cap (3) anchored on the truck in an adjustable manner, each connection including a screw (10) which extends through a shallow slot (e.g., proximate 31, see figure 1) and engages with an aperture (101) on the truck for securing thereto, the toe cap having an anchor section (20) at a bottom face thereof, which is engaged with an anchor cavity (11) on the truck (see figure 3). The reference to Lu fails to teach the adjustment scheme as including a first adjusting member on the heel cap and a second adjusting member on the truck, comprising a screw thread with a turning member at one end, and a mating threaded member which engages with the screw thread, so as to move the heel cap and adjust the size of the skate. Flamm teaches a skate length adjustment device (figures 3, 4), which includes a first member (44) and a second member (41) having a thread at one end, and an actuator (45) at another, wherein the threaded portion (41) engages the first member (44) and whereby turning of the actuator adjusts the relative positions of the heel and toe caps to adjust the skate dimension. It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the threaded adjustment scheme taught by Flamm, connected between the heel cap and truck of the skate

taught by Lu with the second member on the truck and the first member on the heel cup, for the purpose of providing a greater degree of resolution to the adjustability of the skate size, thus allowing a comfortable fit to a greater number of users.

As regards claim 2, the references of Wu as modified by Flamm fail to teach the provision of the first member on the toe cup. A repositioning of already taught parts is considered to be within the skill of the ordinary practitioner (in this case, the movable adjustment of the toe cap with respect to the truck rather than the heel cap), and it would have been obvious to one of ordinary skill in the art at the time of the invention to position the first adjusting device taught by Wu as modified by Flamm on the toe cap for the purpose of allowing the size to be adjusted from the front of the skate.

10. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu in view of Flamm and Wong (US 6,045,144). The references to Wu and Flamm are discussed above and fail to teach the provision of the screw portion which engages the rear of the truck to be connected to the bottom of the toe cap. Wong teaches a size-adjustable skate arrangement including a toe portion (24) and a heel portion (41) where the toe portion bottom surface extends rearwardly to the heel portion, and is provided with downwardly projecting elements (243) which engage through slots (412) in the heel cap. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the toe cap of the skate of Lu as modified by Flamm with a rearwardly projecting bottom as taught by Wong, which engages through slots in the heel cap, and to fasten it using screws as already taught by Wu (e.g., elements 10), so as to present a uniform single piece interior bottom surface, reducing chafing or wear associated with multi-piece bottom shoe constructions.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Pfautz (US 979,795), Slawinski (US 1,342,773), Ecton (US 2,164,805), Segal (US 2,170,162), Budd (US 3,081,106), Frisbie et al. (US 3,291,498), Martin (US 3,635,854), Rothmayer (US 3,993,318), Young (US 5,498,009), Conte (US 6,247,707), and Wong et al. (FR 2,672,812) teach skate devices of pertinence.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 703-308-0424. Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is 703-308-1113.

As of May 1, 2003, any response to this action should be mailed to:
Mail Stop _____
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450,
Or faxed to one of the following fax servers:
Regular Communications/Amendments: 703-872-9326
After Final Amendments: 703-872-9327
Customer Service Communications: 703-872-9325

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

F. VANAMAN
Primary Examiner
Art Unit 3618

12/22/04